

-- REMARKS --

Applicants note that the Examiner failed to comment on the issuance of a new action rejecting claims 1-9, after noting the allowance of those claims in the previous action.

Claim 9 was rejected under §101

The rejection of claim 9 as directed to nonstatutory material is traversed. Claim 9 clearly, and unequivocally, recites “means for” language, invoking paragraph 6 of 35 USC §112. §112 para. 6 claims receive the broadest reasonable interpretation. However, the Examiner’s allegation that claim 9 “appears merely to be a program or software” is misplaced. A program or software that merely exists in the aether cannot possibly be construed as “means for” accomplishing anything, much less the claimed elements, since such ‘aether’ software would not be able to accomplish the claimed limitations. The only possible fashion in which software is able to accomplish the claimed ‘means for’ is to be, for example, included in the Examiner’s argued “processor/computer and memory configured to store an application that includes instructions, which, when executed by the processor, cause the processor to perform operations for carrying out the steps as shown in steps/means (a)-(e)....” While the Applicants thank the Examiner for noting the ‘means for’ language, the Examiner’s rejection is misplaced.

Withdrawal of the rejection to claim 9 is requested.

Claims 1-9 were rejected under §112 first paragraph as failing to comply with the enablement requirement.

The §112 para. 1 rejection is traversed. First, Applicants note that this is the *fourth* office action, and the first appearance of a §112 rejection for these claims, and not a single claim amendment to the rejected claims has been previously made. Further, the Examiner previously rejected *other* claims, on *similar* grounds, while *not* rejecting *these* claims. The Examiner is gently reminded that the goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. See MPEP §706.

By withholding this rejection until now, the Examiner has prejudiced Applicants' ability to secure a full examination and reply competently at the earliest opportunity.

Second, the purpose of the requirement that the specification describe the invention in such terms that one skilled in the art can make and use the claimed invention is to ensure that the invention is communicated to the interested public in a meaningful way. The information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention. However, to comply with 35 U.S.C. 112, first paragraph, it is not necessary to "enable one of ordinary skill in the art to make and use a perfected, commercially viable embodiment absent a claim limitation to that effect." *CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1338, 68 USPQ2d 1940, 1944 (Fed. Cir. 2003) (an invention directed to a general system to improve the cleaning process for semiconductor wafers was enabled by a disclosure showing improvements in the overall system). Detailed procedures for making and using the invention may not be necessary if the description of the invention itself is sufficient to permit those skilled in the art to make and use the invention. The Examiner fails to cite to a single authority that would require a disclosure to "include at least one example" as alleged by the Examiner.

The Examiner cites no authority to support a rejection based on the allegation that an Examiner "has a degree in MIS and an MBA". Does one of ordinary skill in the art have a degree in MIS? Does one of ordinary skill in the art have an MBA? The Examiner continues to fail to define exactly what the skill level in the art is, and therefore these allegations are utterly irrelevant. Similarly, the Examiner fails to cite a single authority that would support a rejection based on reading the "specification at least twice."

In addition, the fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), aff'd. sub nom., *Massachusetts Institute of Technology v. A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985). See also *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404. The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA

1976). Without even alleging that the experimentation is undue, this rejection is unsupported.

The allegation that “the specification merely explains the claims but contains no examples of how the inventions work,” is a statement that the claims *satisfy* §112, and not ground for a rejection under §112. The Examiner apparently agrees that the specification explains the claims, yet rejects the claims under §112? The Examiner fails to cite to any authority for a proposition that the specification must provide “examples of how the inventions work” or that the “number of times” that the Examiner reads a specification affects the patentability of any claims, and therefore appears to be holding the Applicants to an impromptu and extrajudicial standard of patentability.

The mandates of §112 are clear, and unequivocal. Compliance with §112 para. 1 only requires that the information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention. See MPEP §2164. Without identifying the relevant art, and without identifying the skill level in such an art, the Examiner’s rejections cannot stand.

Withdrawal of the §112 para 1 rejections is requested.

Claims 1-9 were rejected under 35 USC §112 para. 2

The rejection of claims 1-9 under §112 para. 2 is traversed. In order to satisfy the strictures of §112 ¶2, the claims need only set out and circumscribe the invention with a reasonable degree of precision and particularity. The definiteness of language is analyzed, not in a vacuum, but in light of the teachings of the disclosure as the disclosure would be interpreted by one of ordinary skill in the art.

The text of the Examiner’s §112 para. 2 is unique, and contrary to law. A rejection under §112 para.2 is based on the definiteness of the language, analyzed as the disclosure would be interpreted by one of ordinary skill in the art. Yet, the rejection ignores such a standard, and focuses instead on “normal” techniques for determining a solution. The Examiner’s allegation that “there is no discussion of a problem, no analysis of the problem and then suddenly step (a) calls for a description of the solution...” is utterly irrelevant to a

§112, para. 2 rejection. Applicants are effectively unable to respond to such a rejection, as it is unfounded in law or in patent practice. Without so much as alleging that the claim language is deficient as it would be understood by one of ordinary skill in the art, the rejection must fall.

Withdrawal of the rejections under §112/2 is requested.

Claims 1-9 were rejected as unpatentable over Hack under §103(a).

The §103(a) rejection is traversed. Hack was filed November 14, 2001, after the filing date of this case (August 9, 2001). Therefore, Hack is not a proper reference against this case. Additionally, Hack is a CIP of an earlier case, and therefore, the only disclosures of Hack that may be attributed a 'priority' date prior to August 9, 2001 are the disclosures within that parent case – which still has published. In order for a reference to qualify as “prior art” the reference must be publicly accessible – an unpublished application is not publicly accessible, and therefore the parent of Hack is also disqualified as a reference, regardless of its teachings. Therefore, Hack cannot be used in an obviousness rejection against these claims.

Specifically, when a U.S. patent, a U.S. patent application publication, or an international application publication is used to reject claims under 35 U.S.C. 102(e), the disclosure relied on in the rejection must be present in the issued patent or application publication. Here, Hack can only possibly qualify as prior art under §102(e), as it published after the filing date of this application. It is the earliest effective U.S. filing date (which will include certain international filing dates) of the U.S. patent or application publication being relied on as the critical reference date and subject matter not included in the patent or application publication itself can only be used when that subject matter becomes public. Subject matter which is disclosed in a parent application, but not included in the child continuation-in-part (CIP) cannot be relied on in a 35 U.S.C. 102(e) rejection over the issued or published CIP. *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967) (The examiner made a 35 U.S.C. 102(e) rejection over an issued U.S. patent which was a continuation-in-part (CIP). The parent application of the U.S. patent reference contained an example II

which was not carried over to the CIP. The court held that the subject matter embodied in the canceled example II could not be relied on as of either parent or child filing date. Thus, the use of example II subject matter to reject the claims under 35 U.S.C. 102(e) was improper.). Here, since the contents of the parent application are secret, Hack cannot be used to support any rejection.

However, even if Hack were a proper reference, which it is not, the recent KSR decision mandates that these claims be found patentable over the prior art. *See, KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) Furthermore, this analysis must be made explicit. *KSR*. Here, the naked assertion that “it would have been obvious to carry out the steps of establishing patterns as part of value chain optimization for shifting activities and responsibilities between business participants in order to evaluate various collaborative business scenario [sic] for now and future comparisons” is utterly unsupported. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). *See also, KSR*.

Withdrawal of the §103(a) rejections is requested.

Applicants request prompt passage to issuance in light of the multiple office actions that have not led to a single claim amendment.

CONCLUSION

The Applicants respectfully submit that claims 1-9 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

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